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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,905	02/16/2001	Hartwig Schlesiger	Mo-6021/WW-5562	3662
157 7590 12/22/2006 BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205			EXAMINER MAIER, LEIGH C	
			ART UNIT 1623	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS			MAIL DATE 12/22/2006	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/785,905	SCHLESIGER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Leigh C. Maier	1623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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### DETAILED ACTION

In view of the new grounds of rejection, PROSECUTION IS HEREBY REOPENED. A detailed action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
SHAOJIA ANNA JIANG, PH.D.  
SUPERVISORY PATENT EXAMINER

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,509,461. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The process recited in the claims of '461 are drawn to a process for producing particulate water-soluble cellulose derivatives comprising (a) forming a feed composition comprising a cellulose derivative, such as a cellulose ether, and 50 wt% to 80 wt% of water; (b) contacting, in a high rotational speed impact mill, the feed composition with a heat exchange gas and a carrier gas (c) separating the particulate cellulose derivative from the gasses; (d) optionally drying the particulate cellulose derivative. Claims further recite the addition of modifiers, additives and active substances to the cellulose derivative.

The claims of '461 do not require a superheated gas or define any particular steam content. However, in the written description of the invention, the gas is characterized as "superheated." See col 12, lines 5-8. The written description further sets preferred ratios of the steam and the carrier gas, which may be air or an inert gas. See col 8, lines 4-10.

The claims of '461 do not require a cellulose derivative having a thermal flocculation point or that the derivative is in the form of a water-moist filter cake. However, the written description of the invention states that the preferred cellulose derivatives are cellulose ethers (as claimed) with a thermal flocculation point, and said cellulose ethers are preferably used in the form of a water-moist filter cake. See col 5, lines 24-25 and col 6, lines 17-18.

The claims of '461 do not require variation of the rotational speed of the jet impact mill in order to adjust the particle-size distribution curve of the product. However, this step is explicitly suggested in the written description of the invention. See col 10, lines 16-20.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare particulate water-soluble cellulose derivatives in the manner of the instant invention because the claims of '461, read in view of the description of the invention, teach every limitation of the instant claims, as set forth above.

Claims 1-3, 5 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3 and 4 of U.S. Patent No. 6,880,772. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The claims of '772 are drawn to the milling and drying of a solvent-moist cellulose derivative, such as cellulose ethers, comprising contacting said derivative to a vapor stream comprising a mixture of steam and either of air or an inert gas. The claims do not recite the use of superheated gas stream or a jet impact mill. However, written description of the invention characterizes gas as superheated, and a wide variety of mills are suggested. See col 6, lines 23-35. See also the examples. Neither do the claims require a particular water content of the original composition or the ratio of the gases in the gas stream.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use superheated gas in the process of the claims of '772 because this is how the carrier gas is described. In the absence of unexpected results, it would be within the scope of the artisan to select an appropriate mill for the process with routine experimentation. Furthermore, regarding the initial water content and the ratio of gasses, given that the desired product is essentially the same as in the instant process, one of ordinary skill would arrive at

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these result-effective variables through routine experimentation with a reasonable expectation of success.

***Allowable Subject Matter***

Claims 1-8 are subject to obvious-type double patenting rejection, but otherwise appear to be free of the art.

The following is a statement of reasons for the indication of allowable subject matter: One of ordinary skill would recognize that a range requiring less than 100% steam in the gas mixture would exclude a process using superheated steam, per se, as in Weber (WO 98/31710). Although steam may be produced in the exemplified process of Bujara (GB 2262527), it would not be superheated, and the reference does not teach or fairly suggest the use of superheated steam.

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*Examiner's hours, phone & fax numbers*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh Maier whose telephone number is (571) 272-0656. The examiner can normally be reached on Tuesday, Wednesday, and Friday 7:00 to 3:30 (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Anna Jiang (571) 272-0627, may be contacted. The fax number for Group 1600, Art Unit 1623 is (571) 273-8300.

Visit the U.S. PTO's site on the World Wide Web at <http://www.uspto.gov>. This site contains lots of valuable information including the latest PTO fees, downloadable forms, basic search capabilities and much more. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov> Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

*Leigh C. Maier*

Leigh C. Maier  
Primary Examiner  
December 15, 2006